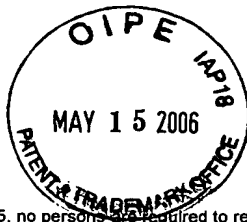


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

72425.0105

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on May 11, 2006

Signature

Typed or printed name John E. Drach

Application Number

10/037,630

Filed

01/03/2002

First Named Inventor

J. Blake Scott

Art Unit

1755

Examiner

Paul D. Marcantoni

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)☐

attorney or agent of record.

Registration number \_\_\_\_\_

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 32,891

Signature

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Typed or printed name

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Telephone number

May 11, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒\*Total of 1 forms is submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the United States Patent Application :  
of Applicant: J. Blake Scott :

Serial No.: 10/037,630 :

Examiner: Paul D. Marcantoni

Filing Date: January 3, 2002 :

Group Art Unit: 1755

Priority Date: August 10, 2001 :

For: **INCORPORATION OF DRILLING CUTTINGS INTO STABLE LOAD-BEARING STRUCTURES**

**Certificate of Mailing Under 37 CFR § 1.8**

I hereby certify that the enclosed Notice of Appeal, Check for the Fee, Pre-Appeal Brief Request for Review, and Arguments In Support Of A Pre-Appeal Brief Request For Review, are being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope properly addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on May 11, 2006.

May 11, 2006  
Date

Georgia Peters  
Georgia Peters

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

**ARGUMENTS**  
**IN SUPPORT OF A PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicant's first argument pertains to a clear deficiency in the *prima facie* case made by the Examiner in support of the rejection of the claims of the instant application. More specifically, Applicant contends that all of the required criteria of a *prima facie* case have not been met by the Examiner. It is well established that the Examiner has the burden of showing that, *inter alia*, the prior art teaches or suggests all the claim limitations in making out a *prima facie* case of obviousness.<sup>1</sup> Applicant contends that there is no teaching or suggestion in the Polston reference of the following instantly claimed limitation.

said load bearing structure having sufficient resistance to rutting that any rut formed in such surface by 10,000 applications of a single axle load will have a depth of rutting that is less than 1 inch.

It is the Examiner's position that this claim limitation would have been an expected property "since the prior [*sic*] (presumably the word "art" was intended to be included after "prior") contains the same exact components and also mixes to form a load bearing [*sic*] (presumably the word "structure" was intend to be included at the end of this quotation).<sup>2</sup> Thus, the Examiner apparently believed that the above claim limitation would be inherent in the process taught by Polston and that such an alleged inherent property would have been obvious at the time the instantly claimed invention was made. However, the Examiner has offered no evidence of any supporting teaching in Polston, or in the prior art in general, of this allegation. Applicant respectfully submits that the Examiner appears to have employed the principles of anticipation-based inherence in making the obviousness rejections. However, this has been

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<sup>1</sup> MPEP 2143.

<sup>2</sup> This quotation is from page 3 of the Office communication mailed 02/17/2005 and is repeated, including the same obvious mistakes, on page 2 of the Office communication mailed 08/03/2005.

held to be improper because it has been held that that which may be inherent is not necessarily known, and that obviousness cannot be predicated on what is unknown.<sup>3</sup>

Applicant's second argument pertains to the rejection of all of the pending claims based upon an improper grouping. Specifically, pending claims 11 and 12 contain limitations requiring a two-stage operation, utilizing fly ash in the first stage and Portland cement in the second stage. Pending claims 12–20 contain limitations for unconfined compressive strength and for minimum thickness. The Examiner has never addressed these limitations, much less pointed out why they should be considered either obvious or *prima facie* obvious in view of the Polston reference. Therefore, these claims should not have been rejected on the same basis as claims 1–10. A grouping together of a plurality of claims in a common rejection that is not equally applicable to all claims in the group is proscribed in MPEP 707.07(d).

Finally, Applicant contends that the Examiner did not give proper consideration to the Declaration of record of Dallas N. Little under 37 CFR 1.132. On page 2 of the final rejection mailed on April 6, 2006, the Examiner stated that the Declaration contained no statement that “. . . Polston would not achieve the load bearing and rutting resistance of applicants' claimed invention.” (*emphasis original*). Dr. Little's Declaration addressed the issue raised by the Examiner as what the person of ordinary skill in civil engineering would expect regarding load bearing and rutting resistance given the teachings of the Polston reference. It is Dr. Little's expert opinion that such a skilled engineer would understand that critical material properties related to the rutting resistance of a representative sample of the entire road structure to be built would have been determined by laboratory testing and the rutting (or plastic deformation) rate and/or magnitude has been reliably estimated by well-established and empirically derived correlations between pavement properties and observed practice. Dr. Little's opinion is not merely conclusory but is based on the analysis set forth on pages 3–5 of the Declaration.

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<sup>3</sup>

*In re Spormann*, 150 USPQ 449, 452 (C.C.P.A. 1966).

Applicant respectfully requests a thorough consideration of the above arguments, which show a clear deficiency in the *prima facie* case in support of a rejection made by the Examiner in the instant application.

Respectfully submitted,



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